

### REMARKS

These Remarks are in reply to the final Office Action mailed February 18, 2004. Claims 1-3, 5-9 and 22 are hereby amended, claim 31 has been added and claim 2 has been canceled, such that claims 1 and 3-31 are currently pending.

#### Request for Withdrawal of Finality of Office Action

The Office action mailed February 18, 2004 was improperly made final by the Examiner. Entirely new grounds of rejection were applied to all claims, and the Office suggests on page 7 that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action." This is untrue.

The only amendments made prior to this Office action were in changing the term "disc drive" in certain claims to "information handling device." Both the previously applied reference (U.S. Patent 6,046,889 to Berding et al.) and the currently applied reference (U.S. Patent 5,016,131 to Riggle et al.) disclose information handling devices in the form of disc drives. The amendment in no way necessitated a shift in reliance upon one reference to the other.

In addition, it was previously indicated that claim 17 included allowable subject matter. Neither this claim nor claim 9 from which it depends have been amended in any way prior to the issuance of the "final" Office action. As such, a new rejection of claim 17 cannot possibly be "necessitated" by an amendment, and to make such a rejection final is simply impermissible.

In short, contrary to the Office's contention, the amendment in no way "necessitated" the new ground of rejection. In fact, its withdrawal was necessitated only by the Office's initial failure to properly make out a case of anticipation. Patent Examination rules, as well as basic fairness, require that Applicant be given a real opportunity to amend and respond to a new, arbitrarily imposed ground of rejection.

Withdrawal of the finality of the previous Office action is respectfully requested. In addition, entry and consideration of the amendment is also respectfully requested.

**Restriction Requirement**

Applicant thanks the Examiner for withdrawing the previously imposed restriction requirement.

**Rejection under 35 U.S.C. § 112**

Claim 22 was rejected under 35 U.S.C. § 112, second paragraph as being indefinite because "the disc drive" lacks antecedent basis in lines 2-3.

Claim 22 has been amended to remove reference to a "disc drive." Withdrawal of the rejection is respectfully requested.

**Rejection under 35 U.S.C. § 102**

Claims 1-4, 8-9, 18-24 and 28-30 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,016,131 to Riggle et al. (hereinafter "Riggle").

Claim 1 as amended recites and actuator assembly comprising "a stationary shaft, a main body having an opening and magnets being supported by the main body within the opening." Riggle discloses only magnets 17,18 which are mounted to a stationary shaft 16, and not to the main body 11 of the actuator. For at least this reason, Riggle does not show each and every element of claim 1 and therefore cannot reasonably be said to anticipate claim 1.

Claims 2-4, 8 and 28 depend from claim 1 and are allowable for at least this reason.

Claim 9 recites an information handling system comprising "a coil attached to [a] yoke" as well as requiring that "the actuator assembly [be] capable of swinging through an arc and rotatably attached to the base about the yoke." The Office suggests on page 3 of the Office action that elements 10,11 respond to the "yoke" limitation. However, this makes no sense. First, there is no way cylindrical element 11 can be reasonably be considered a "yoke" - if the Office has some basis for this designation, some support is respectfully requested. Second, the Office has already deemed part of the "main body"

(paragraph 4 of the Office action). As such, it is simply not possible for Riggle's actuator assembly to rotate about the "yoke" as they are defined by the Office. Because Riggle cannot reasonably be construed as meeting the limitations set forth above, withdrawal of the rejection and allowance of claim 9 is respectfully requested.

Claim 18 depends from claim 9 and is allowable for at least this reason.

Claim 19 recites "means for moving the actuator assembly, the moving means being attached to the actuator assembly." Berding does not disclose means for moving the actuator assembly. For at least this reason, withdrawal of this rejection and allowance of claim 19 is respectfully requested.

Claims 20-24, 29 and 30 depend from claim 19 and are allowable for at least this reason.

#### **Claim Rejections - 35 U.S.C. § 103**

Claims 5-7, 10-15, 17 and 25-27 were rejected under 35 U.S.C. § 103(a) as being obvious over Riggle.

Claims 5-7 depend from claim 1 while claims 25-27 depend from claim 19 and are allowable for at least this reason, but are allowable for additional reasons as well. The Office acknowledges that Riggle does not disclose magnets which are oriented orthogonally to one another (as required by claims 5 and 25), circularly (as required by claims 6 and 26) or as a Halbach array (as required by claims 7 and 27). Rather than making a *bon fide* attempt to address the shortcomings however, the Office has effectively brushed them off by insisting that to so modify Riggle would represent "obvious rearranging of parts . . . in order to improve magnetic flux between magnets and coils." Such a statement is simply not reasonable, given that Riggle discloses only stationary magnets on a stationary shaft. Riggle simply does not lend itself to the bizarre modifications proposed by the Office. It is clear that the Office has merely used the present application as a roadmap in an effort to mangle Riggle to meet the

limitations of these claims. Such hindsight is impermissible. Withdrawal of the rejections of claims 5-7 and 25-27 is respectfully requested.

Claims 10-15 and 17 depend from allowable claim 9 and are themselves allowable for at least this reason.

Regarding claim 13, the Office suggests that, despite the fact that Riggle fails to even disclose a yoke, that to make such a yoke of the materials recited in claims 13 and 14 would have been obvious "to improve rotation characteristics" given that it is "within the general skill of a worker in the art to select a known material on the basis of its suitability." Again, Riggle does not even disclose a yoke as set forth in claim 9. As such, claims 13 and 14 are allowable at the very least based upon their dependence from allowable claim 9.

#### Newly Submitted Claims

Newly submitted claim 31 depends from claim 9 and is allowable for at least this reason.

#### Allowable Subject Matter

The Examiner is thanked for the indication that claim 16 includes allowable subject matter. Because it is believed that claim 9 is allowable as filed, the claims have not been amended as proposed by the Examiner.

#### Conclusion

For reasons set forth above, Applicant respectfully asserts that present claims particularly point out and distinctly claim the subject matter which is regarded as the invention. In addition, the present invention as claimed is not taught by the prior art of record or any combination thereof. Therefore, it is respectfully submitted that the pending claims are in condition for allowance, and favorable action with respect to the present application is respectfully requested.

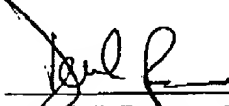
In addition, entry and consideration of the present amendment are respectfully requested, for reasons set forth regarding the impropriety of the Office having made the most recent Office action final.

If the Examiner is not satisfied, but minor changes would apparently put the present case in condition for allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

Seagate Technology LLC  
(Assignee of the Entire Interest)

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Date

  
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